

Amend Description of the Mark

Amend the description of the mark to read as follows:

The mark consists of the three dimensional design of packaging for marbles comprising the combination of a square placard with a net bag for retaining marbles, wherein the top of the net bag extends through a central hole in the bottom of the placard and is tied at the back of the placard to secure the bag such that it hangs down from the placard in the shape of a pouch and wherein the square placard has a border extending around the perimeter of the front and back of the placard.

Applicant's Mark Functions as a Trademark.

The Examining Attorney refused registration on the basis that the applicant's packaging design is used by a number of different marble manufacturers and therefore does not function as a trademark. Applicant asserts that all of the packaging relied upon by the Examiner having the same design is, in fact, the Applicant's packaging. The Applicant's packaging design is unique in the industry, creates a very different commercial impression from that of the other manufacturers and is highly distinctive. Reconsideration is requested.

Applicant's Packaging Design is Different and Distinguishable from Others

Applicant asserts that its packaging design is very different from those of other manufacturers and does serve as an indicator of source. Applicant's packaging conveys a significantly different commercial impression from the packaging of other manufacturers. Contrary to the Examining Attorney's position, the examples cited by the Examining Attorney actually support registrability by showing that applicant's packaging design is unique to the industry.

Applicant has amended the description of the claimed mark to make clear that Applicant's packaging design includes the three dimensional appearance of the Applicant's marble packaging which comprises the combination of a square placard with a net bag for retaining marbles. The top of the net bag extends through a central hole in the bottom of the placard and is tied at the back of the placard to create a pouch shaped bag hanging from the bottom of the placard. The placards can be hung for display on a rack with the pouch of marbles hanging down from the bottom of the placard. All of the examples of marble packaging cited by the Examining Attorney having the claimed design are manufactured by or on behalf of Applicant. Specifically, Applicant notes that all of the following examples cited by the Examining Attorney depict the Applicant's products and packaging:

1. Attachment 4, second column, fourth row;
2. Attachment 7;
3. Attachment 8;
4. Attachment 10;
5. Attachment 11; the second, third and fourth packages of marbles, if numbering from left to right;
6. Attachment 15;

7. Attachment 18;
8. Attachment 19 (all five packages);

It is noted that all of these examples refer either to the Applicant "FS USA" or "Fabricas Selectas" or to the "MEGA" brand of marbles which is Applicant's trademark (U.S. Registration No. 2,205,557)

All of the other examples of marble packaging cited by the Examining Attorney are markedly different in appearance and design from that of Applicant's packaging. Some other manufacturers use net bags to hold the marbles, but they have a very different overall appearance. For example, the packaging shown in Attachments 24 and 27 consists of net bags attached to either a circular or a square placard with a plastic hanging clip that extends through the top-center or top of the placard. The placards do not include a border. It appears that this packaging would either be hung on a display via the clip or would be simply displayed setting on a shelf. Attachments 1, 6 and 20 show packaging using net bags attached along the entire bottom edge of a rectangular placard. The net bags do not extend through a central hole in the placard and do not form a pouch shape.

It would also appear from some of the packaging cited by the Examining Attorney consists of clear plastic bags attached to rectangular placards (See Attachments 2, 3 & 4). The plastic bags in these examples are attached to rectangular placards across the entire bottom edge of said placards. Notably, the plastic bags do not extend through a central hole in the placards and do not form a pouch shape.

Overall in comparing the various depictions of the Applicant's packaging shown in Attachments 4, 7, 8, 10, 11, 15, 18 and 19 to the other packaging designs, it is clear that the overall appearance and commercial impression is very different. The Applicant's packaging is unique and distinguishable.

Applicant's Packaging Design is Inherently Distinctive

Applicant's mark is inherently distinctive, as it is "so different...that it will immediately be perceived as a source identifier, not merely or solely as an attractive decoration or embellishment." J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS, Chapter 8, p. 79. The test outlined in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 is the "preferable test" to apply in determining whether packaging is inherently distinctive trade dress. *Id.* at 78–79. The *Seabrook* test requires one to ask:

1. Whether the design or shape is a common, basic shape or design;
2. Whether it was not unique or unusual in a particular field;
3. Whether it was a mere refinement of a commonly-adopted and well known form of ornamentation for a particular class of goods which consumers would view as mere ornamentation.

Id. at 75.

Applicant's mark is not "a common, basic shape or design." As discussed above and as depicted in the drawings, applicant's mark is the only one which consists of a knotted, net bag attached to a square, bordered placard. Further, the mark is "unique" as compared to the packaging utilized by other manufacturers of marbles. Finally, the mark cannot be fairly characterized as "a mere refinement" of the packaging utilized by other manufacturers of marbles given that, when the mark is viewed as a whole, it clearly stands out from the rest.

Applicant's Mark is Not Merely Functional.

For many of the same reasons outlined above, the following statements hold true:

- Applicant's mark is not functional because it is not essential to the use or purpose of the product and it does not affect the cost or quality of the product.
- Applicant's mark does not provide a utilitarian advantage to the user of the product.
- Applicant's mark is not one of a few superior designs available for the packaging of the product.
- Applicant's mark is one of many equally feasible, efficient and competitive designs.

Attached to the office action are numerous examples of packaging for marbles that do not utilize Applicant's mark: a net bag affixed to the bottom center of a square, bordered placard. Were Applicant's mark to be registered as a trademark, other manufacturers would not be prevented from using net bags combined with placards to package marbles, they would only be prevented from using Applicant's unique and distinctive combination of a net bag and placard. A number of alternative packaging designs are shown in the examples cited by the Examining Attorney and there are undoubtedly many other conceivable alternatives available to manufacturers that are not depicted in the various examples attached to the office action.

In sum, the Applicant's packaging design is not functional. There are many different designs of packaging that can be used by others incorporating a net bag and a placard without using the same design as that of Applicant.

Applicant's drawing does not depict more than one mark.

The Examining Attorney refused registration on the basis that the applicant's drawing shows more than one rendition of a three-dimensional mark. Applicant asserts that the drawing does not show more than one rendition of a three-dimensional mark; rather, the drawing depicts spatially separate elements of the same mark. Specifically, the drawing depicts the front and back of Applicant's mark. These separate aspects, viewed together, are a single mark projecting a unitary commercial impression.